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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/573,972	03/30/2006	Yasutaka Takada	127573	9934
25944 7590 09/22/2009 OLIFF & BERRIDGE, PLC P.O. BOX 320850 ALEXANDRIA, VA 22320-4850				
EXAMINER				
ROBINSON, BINTA M				
ART UNIT		PAPER NUMBER		
1625				
MAIL DATE		DELIVERY MODE		
09/22/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Advisory Action  
Before the Filing of an Appeal Brief**

**Application No.**

10/573,972

**Applicant(s)**

TAKADA ET AL.

**Examiner**

BINTA M. ROBINSON

**Art Unit**

1625

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 17 August 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.  
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 1, 2 and 6.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

/Janet L. Andres/  
Supervisory Patent Examiner, Art Unit 1625

/Binta M Robinson/  
Examiner, Art Unit 1625

The applicant traverses the 103 (a) rejection over Sakoda in view of Brittain stating that the office action acknowledges that "Sakoda at least does not disclose " dissolving a racemate of the compound of formula (1) solvent" . However, the office action dated 4/15/09 never made this statement. In fact, the Sakoda reference actually states on page 2378 "the residue was crystallized from toluene to give pale yellow crystals, which were composed of equimolecular amounts of (S,S)-3, (R,S)-3, and toluene. Because an attempt to separate them by repeated recrystallization was unsuccessful, the diastereomeric mixture of 3 was subjected to subsequent reactions, from which 5 was derived, and finally (R)-6 was obtained in 100% enantiomeric purity by recrystallizations from ethanol." The applicant further traverses the Sakoda rejection stating that Brittain discloses that the direct crystallization techniques are "necessarily limited to racemates which crystallize as conglomerates,". A conglomerate is only one type of racemic mixture, and the term "racemate" in applicant's claim 1 does not exclude conglomerates but actually includes conglomerates. It is well known to one of ordinary skill in the art that racemic mixtures can crystallize as conglomerates. The applicants' claims do not limit racemates to only "true racemates" for which crystallization methods are not useful. Therefore, the applicant's arguments regarding "conglomerates" are not persuasive. The applicant also applies the same reasoning to Matsumoto and Brittain that it applies to Sakoda in view of Brittain. The examiner also responds with the same reasoning above, as to why the applicants' arguments are not persuasive regarding Matsumoto in view of Brittain. Applicants' claims do not limit the term "racemate" to only conglomerates - this term "racemate" actually includes conglomerates. The argument about the rarity of finding "conglomerates" in a racemic mixture is also not persuasive, because even if more "true racemates" exist in the racemate than conglomerates, as long as conglomerates do exist in the racemic mixture, in the applicant's process, which is possible, then the prior art would render obvious the instant process in view of Brittain. The applicant did not mention in the interview summary dated 1/27/09, their dispute with the availability of the Matsumoto reference's translation and the applicant even discusses the merits of the Matsumoto rejection in the response dated 1/22/09, - so therefore, the finality of the office action dated April 2009, will not be overturned.